

### **ELECTION/RESTRICTION**

With respect to Office Action paragraph 1, nonelected Claims 9 - 31 are cancelled without prejudice.

### **SPECIFICATION**

With respect to Office Action paragraph 2, the specification has been amended to delete [R] on page 10, lines 11-12, cancelling introduced new matter.

### **CLAIM OBJECTIONS**

With respect to Office Action paragraph 3, Claims 1 and 2 have been cancelled, thereby eliminating recited sequences to comply with the Sequence Rules.

### **DOUBLE PATENTING**

With respect to Office Action paragraph 4, Claim 1 has been cancelled, and Claims 3 and 4 have been amended. A terminal disclaimer is provided herewith to obviate rejection of Claims 3 to 8 as being unpatentable over claims 1, 3-5 and 6-9 of U.S. Patent No. 5,696,080.

### **REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH.**

The rejection of claims 1-8 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention at the time the application was filed is respectfully traversed.

With respect to Office Action paragraph 5, the Examiner has rejected Claims 1-8 under 35 U.S.C. 112, first paragraph, for lack of proper antecedent basis. Claims 1 and 2, claims reciting a generic consensus sequence containing new matter have been cancelled.

The Examiner is respectfully requested to allow amended Claims 3-8, which are

no longer referring to a consensus sequence.

With respect to Office Action paragraph 6, cancellation of Claims 1 and 2 removes the cited consensus sequence algorithm, leaving only specific sequences SEQ ID NO: 1 and SEQ ID NO: 2.

Accordingly, by amendments herein, the specification sufficiently describes the invention as required by 35 USC §112, first paragraph. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. §112, first paragraph, be withdrawn.

With respect to Office Action paragraph 7, cancellation of Claims 1 and 2 and amendment of Claims 3 and 4, leaves only peptides consisting of SEQ ID NO: 1 or 2 as prosaposin receptor antagonists, peptides considered enabled by the Examiner.

Accordingly, the Examiner is respectfully requested to eliminate this rejection.

#### **REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

The Examiner has rejected Claims 4-8 under 35 USC §112, second paragraph, for being incomplete in that the intended use of the recited pharmaceutical compositions is not stated.

With respect to Office Action paragraph 8, Claims 4-8 have been amended to state that these compositions would be useful in treating neuropathic pain, and a range for effective dosage has been provided to aid in determining the actual effective dose. Support for this range is found on page 42, line 28.

Applicant respectfully requests the Examiner to find these claims complete and allowable.

#### **REJECTIONS UNDER 35 U.S.C. § 102.**

The Examiner rejected Claims 1 and 3-8 under 35 USC §112 as being anticipated

by O'Brien et al., US Patent 5,696,080. Applicant respectfully traverses.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. See *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir., 1995). Anticipation is an issue of fact, see *In re Graves*, 69 F.3d 1147, 1141, 36 USPQ2d 1697, 1700 (Fed. Cir. 1995); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7, USPQ2d 1315, 1317 (Fed. Cir., 1988), and the question whether a claim limitation is inherent in a prior art reference is a factual issue on which evidence may be introduced, see *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir., 1991).

With respect to Office Action paragraph 9, Claim 1 has been cancelled and Claims 3 - 8 consider not fragments of saposin C, but very specific peptide sequences, SEQ ID NO: 1 and 2. The referral to "carriers" is merely intended to complete the description of the method of use. The use of the carriers named is old art. The combination with these specific sequences is not.

To borrow the analysis of the Examiner citing Rudinger, the amino acid sequences, even if identical, are not expected to act in an analogous manner, where they are found in a totally different milieu within a larger molecule. A sequence found in a larger molecule, fragment of saposin C, even if identical to a peptide, would not be expected to have the same effect, with the same efficiency.

With respect to Office Action paragraph 10, Claims 1 and 3 - 8 have been rejected under 35 USC 102(f), because Applicant did not invent the claimed subject matter.

Claim 1 has been cancelled. Applicant respectfully submits that inventorship of subject matter described in Claims 3-8, as amended, is not in doubt.

Under § 102(f), patentability is not precluded "under this section where the

subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

The Regents of the University of California are, and were, owners of the patent and application in question. O'Brien is the inventor or co-inventor in both. Even if the subject matter were developed by a co-worker in the same organization, which it was not (see hereinabove), the patent cited is not prior art. In order to prove such a patent is prior art, it is necessary to show (1) the invention was conceived by another and (2) the conception by another was communicated to that person. Hildreth, Patent Law: A Practitioner's Guide.

### CONCLUSION

In summary, for the reasons set forth herein, Applicant maintains that claims 3 - 8, as now amended, clearly and patentably define the invention. Therefore, Applicant respectfully requests that the Examiner reconsider the various grounds set forth in the Office Action, and allow the claims now pending.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicants' representative can be reached at (760) 788-7401.  
Respectfully submitted,

Date:

11/18/00

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